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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/703,839

Applicant(s)

TAKAGI, SHIRO

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-15 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other

### DETAILED ACTION

Receipt is acknowledged of the information disclosure statement filed on 10/25/2001, which has been entered in the file. Claims 1-15 are pending.

#### *Specification*

1. The abstract of the disclosure is objected to because the abstract is greater than one paragraph and is greater than 150 words. Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities:

Page 1:

Line 26, "in" should be deleted.

Line 33, --reader-- should be inserted after the first occurrence of "code".

Page 3:

Line 25, "increases" should be replaced with --includes--.

Line 35, --the-- should be inserted after the first occurrence of "in".

Page 7, line 13: "3" should be replaced with --3b--, since printer 3b is the printer not connected to the Internet (see figure 1).

Page 8, line 15: "21" should be replaced with --2--, since the electronic information server is labeled "2" (see page 8, line 2, and figure 4).

Page 13, line 12: "21" should be replaced with --15--, since the electronic information storage portion (in the portable communication terminal 1) is labeled 15 (see figures 4, 16, and page 13, lines 9-13).

***Claim Objections***

3. Claims 8, 12, and 15 are objected to because of the following informalities:

Claim 8:

Line 14: "increases" should be replaced with --includes--.

Claim 12:

Line 6, "transmit/received" should be replaced with --transmit/receive--.

Line 11, --information-- should be inserted after "electronic", in order to clarify that the claim is referring to the "electronic information server" as recited in line 5.

Line 20, "said" should be replaced with --a--, in order to avoid a lack of proper antecedent basis for "said printing device".

Claim 15, line 2: --wherein-- should be inserted before "said", in order to improve readability of the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 8-11: Claim 8, lines 22-23 read, "... upon receiving said print designation information from said scanner ...", which indicates that the print designation information is transmitted from the scanner, however, lines 15-19 read, "a scanner for

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reading the bar code recorded on said bar code recording medium; and information transmitting means for transmitting information read by said scanner and print designation information to said printing device," which indicates that the print designation information is transmitted by the transmitting means, not the scanner. This renders the claims indefinite. For examination purposes, the claims have been interpreted to mean that the print designation information is transmitted by the transmitting means, not the scanner.

Re claims 12-15: Claim 12, lines 23-24 read, "... upon receiving said print designation information from said scanner", which indicates that the print designation information is transmitted from the scanner, however, lines 16-20 read, "a scanner for reading the bar code recorded on said bar code recording medium; and information transmitting means for transmitting information read by said scanner and print designation information to said printing device", which indicates that the print designation information is transmitted by the transmitting means, not the scanner. This renders the claims indefinite. For examination purposes, the claims have been interpreted to mean that the print designation information is transmitted by the transmitting means, not the scanner.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson (US 5,939,695).

Nelson teaches an electronic information management system comprising: a portable communication terminal (3) capable of transmitting/receiving data through a network (a wireless network, see column 3 line 3-27), an electronic information server (for example, a retail establishments computer system, not shown, see column 3 lines 3-13) which can transmit/receive data through the network and which records a plurality of electronic information including document data (product information, which may take the form of text, graphics, etc., see column 2 line 50 - column 3 line 1), a first printing device (represented by block 80, figure 3) capable of receiving print data through the network, a bar code recording medium (the medium on which a products universal product code is printed, see column 2 lines 27-30) on which a bar code (the products universal product code) for specifying a storage position of the electronic information is recorded (since the product information is retrieved by reading a universal product code, the universal product code is used as a pointer to the storage position of the product information), wherein the portable communication terminal includes: a scanner (bar code reader 12) configured to read the bar code recorded on the bar code recording medium, search conditions directing means (logic circuitry 10) configured to transmit search conditions of electronic information to the electronic information server based on information read by the scanner (the logic circuitry 10 generates a signal requesting product information related to the scanned universal product code), electronic information storing means (the terminal 3 necessarily includes a memory for storing

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data transmitted from the computer system, see column 2 line 50 - column 3 line 7)

configured to store electronic information which meets the search conditions transmitted from the electronic information server, print designating means (means which allow the customer to choose the format of paper and transmit the printing order to the printer, see column 3 lines 39-53) configured to transmit the electronic information stored in the electronic information storing means to the first printing device to perform printing; a second printing device (86) which receives the electronic information from the portable communication terminal without using the network (the terminal 3 is docked at the printer station to transmit the printing order to the printer, see figures 3, 4 and column 44-48) and which performs printing; the portable communication terminal including: displaying means (6) capable of displaying character information, menu display controlling means (within logic circuitry 10) configured to display a menu for selecting various kinds of functions on the displaying means (the PCS 3 prints a message on display 6 which indicates to the customer the options presently available, see column 2 lines 45-52), and key inputting means (9) configured to select functions in accordance with the menu (see figures 1-4, column 1 line 48 - column 2 line 6, column 2 line 27 - column 3 line 27, and column 3 line 39 - column 4 line 8).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Yacoub (US 6,452,692 B1).

The teachings of Nelson have been discussed above.

While Nelson teaches the portable communication terminal (3) displaying a message indicating where the customer may pick up the printed information (see column 3 lines 49-53), Nelson fails to specifically teach upon completion of printing of the electronic information transmitted from the portable communication terminal, the first printing device transmits a signal indicating the completion to the portable communication terminal.

Yacoub teaches a system wherein upon completion of a print job, the printer transmits a signal indicating completion to the client station on which the print job originated (see column 15 lines 43-46).

In view of Yacoub's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Nelson, upon completion of printing of the electronic information transmitted from the portable communication terminal, the first printing device transmits a signal indicating the completion to the portable communication terminal, in order to give the user a clear indication that the print job has actually been completed, thereby preventing the user from expending time and effort trying to retrieve a print job that has not been completed.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Knowles (US 6,068,188).

The teachings of Nelson have been discussed above.



While Nelson teaches that the bar code recording medium (the medium on which the universal product code is printed, see column 2 lines 27-30) records a bar code for specifying the storage position of the electronic information (product information), Nelson fails to teach a bar code for specifying an attached material of the electronic information.

Knowles teaches an electronic information management system wherein a bar code recording medium records a bar code (the upper bar code in figure 9) for specifying the storage position of electronic information (for example: <http://www.metrologic.com>) and a bar code (the lower bar code in figure 9) for specifying an attached material (for example: </products/ms6720.html>) of the electronic information (see figure 9 and column 15 line 59 - column 16 line 16).

In view of Knowles teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Nelson, the bar code recording medium including a bar code for specifying an attached material of the electronic information, in order to allow the use of shorter length bar code symbols (since the storage position of the electronic information does not need to be included with each of the storage positions of the attached material) on printed menus and lists (see column 15 lines 59-64).

11. Claims 8, 10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Marsh et al (US 5,423,617).

Re claims 8 and 10: The teachings of Nelson have been discussed above.

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Nelson fails to teach the printing device downloading electronic information corresponding to the information read by the scanner from the electronic information server upon receiving the print designation information.

Marsh et al teaches an electronic information management system, including: a scanner (not shown in figure 7) for reading a bar code recorded on a bar code recording medium, and a printing device (CPU 102, print head driver 114, print head 116) which downloads electronic information (for example, price information) corresponding to the information read by the scanner from an electronic information server (PC 26) upon receiving print designation information (instructions to print) (see figure 7, column 2 lines 11-17, column 4 lines 38-53, and column 7 lines 21-63).

In view of Marsh et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Nelson, the printing device downloading electronic information corresponding to the information read by the scanner from the electronic information server upon receiving the print designation information, in order to ensure that the most up to date electronic information is printed, since the electronic information is downloaded just prior to printing.

Re claims 12 and 14: Nelson also teaches an electronic information management system comprising: a portable communication terminal (3) having a communication function (a function for communicating with a wireless network, see column 3 line 3-27), an electronic information server (for example, a retail establishments computer system, not shown, see column 3 lines 3-13) which can transmit/receive data through a network

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(a wireless network) and which records a plurality of electronic information including document data (product information, which may take the form of text, graphics, etc., see column 2 line 50 - column 3 line 1), a My electronic server (the terminal 3 necessarily includes a memory, which can be considered a My electronic information server, for storing data transmitted from the computer system, see column 2 line 50 - column 3 line 7) capable of downloading at least a part of the electronic information recorded in the electronic information server through the network, a bar code recording medium (the medium on which a products universal product code is printed, see column 2 lines 27-30) on which a bar code (the products universal product code) for specifying a storage position of the electronic information is recorded (since the product information is retrieved by reading a universal product code, the universal product code is used as a pointer to the storage position of the product information), the portable communication terminal includes: a scanner (bar code reader 12) configured to read the bar code recorded on the bar code recording medium, information transmitting means (means which allow the customer to choose the format of paper and transmit the printing order to the printer, see column 3 lines 39-53) for transmitting information read by the scanner and print designation information (instructions to print) to a printing device (represented by block 80, figure 3); the portable communication terminal including: displaying means (6) capable of displaying character information, menu display controlling means (within logic circuitry 10) configured to display a menu for selecting various kinds of functions on the displaying means (the PCS 3 prints a message on display 6 which indicates to the customer the options presently available, see column 2 lines 45-52), and key

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inputting means (9) configured to select functions in accordance with the menu (see figures 1-4, column 1 line 48 - column 2 line 6, column 2 line 27 - column 3 line 27, and column 3 line 39 - column 4 line 8).

Nelson fails to teach the My electronic information server downloading electronic information corresponding to the information read by the scanner from the electronic information server upon receiving the print designation information.

Marsh et al teaches an electronic information management system, including: a scanner (not shown in figure 7) for reading a bar code (not shown) recorded on a bar code recording medium (not shown), a My electronic information server (memory 108) which downloads electronic information (for example, updated pricing information) corresponding to the information (for example, shelf number) read by the scanner from an electronic information server (a central computer) upon receiving print designation information (an instruction to print) (see figure 7, column 2 lines 11-17, column 4 lines 38-53, and column 7 lines 21-63).

In view of Marsh et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Nelson, the My electronic information server downloading electronic information corresponding to the information read by the scanner from the electronic information server upon receiving the print designation information, in order to ensure that the most up to date electronic information is printed, since the electronic information is downloaded just prior to printing.

12. Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson as modified by Marsh et al in view of Yacoub.

The teachings of Nelson as modified by Marsh et al have been discussed above.

Nelson as modified by Marsh et al fails to specifically teach upon completion of printing of the electronic information transmitted from the portable communication terminal, the first printing device transmits a signal indicating the completion to the portable communication terminal.

The teachings of Yacoub have been discussed above.

In view of Yacoub's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Nelson as modified by Marsh et al, upon completion of printing of the electronic information transmitted from the portable communication terminal, the first printing device transmits a signal indicating the completion to the portable communication terminal, in order to give the user a clear indication that the print job has actually been completed, thereby preventing the user from expending time and effort trying to retrieve a print job that has not been completed.

13. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson as modified by Marsh et al in view of Knowles.

The teachings of Nelson as modified by Marsh et al have been discussed above.

Nelson as modified by Marsh et al fails to teach a bar code for specifying an attached material of the electronic information.

The teachings of Knowles have been discussed above.

In view of Knowles teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Nelson as modified by Marsh et al, the bar code recording medium including a bar code for specifying an attached material of the electronic information, in order to allow the use of shorter length bar code symbols (since the storage position of the electronic information does not need to be included with each of the storage positions of the attached material) on printed menus and lists (see column 15 lines 59-64).

***Allowable Subject Matter***

14. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: While the prior art of record, such as Nelson (US 5,939,695), teaches reading a bar code and displaying information stored in a server in relation to the bar code data, the prior art of record, taken alone or in combination, fails to teach or fairly suggest: data type display controlling means configured to display first information indicating that a data main body of the electronic information is stored in the portable communication terminal, and second information indicating that the data main body of the electronic information is not stored in the portable communication terminal but information representing a storage position of the electronic information is stored in the portable communication terminal, in combination with the other claimed limitations as set forth in the claims.

**Conclusion**

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fano et al (US 2002/0133545 A1), Parry (US 2002/0131071 A1), Kato et al (US 2001/0011283 A1), Walsh et al (US 6,144,848), Chokai et al (JP 2002-55987 A), and Todo et al (JP 2001-249871 A) all teach electronic information retrieval systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*Jared J. Fureman*  
Jared J. Fureman  
September 25, 2002